21

FILED
MAY 16 19
CHARLES ELMORE CR

IN THE

SUPREME COURT OF THE UNITED STATES

OCTOBER TERM, 1945

NO. 1233

THE E. L. ESSLEY MACHINERY COMPANY,
an Illinois Corporation,
Petitioner,

vs.

THE DELTA MANUFACTURING COMPANY,
a Delaware Corporation,
Respondent.

PETITION FOR A WRIT OF CERTIORARI
To the Circuit Court of Appeals
For the Seventh Circuit, and
BRIEF IN SUPPORT THEREOF.

JOHN W. MICHAEL,
GERRIT D. FOSTER,
Counsel for Petitioner.

HANNERSMITH-KORTHEYER CO. MILWAUKEE

INDEX

	Page
Petition	1
Summary and Short Statement of the Matter Involved	2
The Gravamen	2
The Alleged Invention	3
The Prior Art	4
The Findings and Decisions of the Courts Below	7
Reasons Relied upon for the Granting of a Writ of Certiorari	8
Brief in Support of Petition	11
The Opinions of the Courts Below	11
Jurisdiction	11
Statement	11
Specification of Errors	11
Summary of Argument	12
Argument	12

Authorities Cited

Altoona Publix Theatres, Inc. v. American Tri-Ergon Corp., 294 U.S. 477, 487	8, 11, 12
American Road Machine Co. v. Pennock and Sharp Company, 164 U.S. 26	9
Ansonia Co. v. Electrical Supply Co., 144 U.S. 11, 18	15
Concrete Appliances Co. et al. v. Gomery et al., 269 U.S. 177	9

Page

Cuno Engineering Corporation v. Automatic Devices Corp., 314 U.S. 84, 91 15

Dow v. Halliburton, 65 S. Ct. 647, 650; 324 U.S. 320 15

Electric Cable Joint Co. v. Brooklyn Edison, 292 U.S. 69, 79 ..... 9, 18

Ford Motor Co. v. Parks & Bohne, C.C.A. 6th, 21 Fed. (2d) 943, 946 16

General Electric Co. v. Wabash Appliance Corporation, 304 U.S. 364, 369 ..... 8, 9

Grinnell Washing Machine Co. v. Johnson Co., 247 U.S. 426, 433-4 ..... 9, 17

Grosjean et al v. Panther-Panco Rubber Co., Inc., C.C.A. 1st, 113 Fed. (2d) 252, 256 16

Hookless Fastener Co. v. G. E. Prentice Mfg. Co., C.C.A. 2nd, 68 Fed. (2d) 940, 941 16

Lincoln Co. v. Stewart-Warner Corp., 303 U.S. 545, 546 11

McCarty v. Lehigh Valley R. R. Co., 160 U.S. 110, 116 ..... 8, 13, 16

Mercoid Corporation v. Mid-Continent Investment Co., 320 U.S. 661, 665 ..... 9, 19

Milcor Steel Co. v. George A. Fuller Co., 316 U.S. 143, 145 ..... 8, 13

Morton Salt Co. v. Suppiger Co., 314 U.S. 488, 490.. 11

Pennsylvania Railroad Company v. Locomotive Truck Co., 110 U.S. 490, 494-496 15

Phillips v. Page, 24 How. 164, 167 15

Potts v. Creager, 155 U.S. 597, 608 15

Page

Powers-Kennedy Contracting Corporation, et al v. Concrete Mixing and Conveying Co., 282 U.S. 175, 180, 186 ..... 9, 18

Roberts v. Ryer, 91 U.S. 150, 157 15

Schriber Co. v. Cleveland Trust Co., 311 U.S. 211, 217 11

Sinclair & Carroll Co. v. Inter-Chemical Corp., 65 S. Ct. 1143, 1145; 325 U.S. 327 9

Stearns v. Russell, 85 Fed. 218, 224, C.C.A. 6th, certiorari denied 171 U.S. 689 16

United Carbon Company v. Binney & Smith Co., 317 U.S. 228, 232 9

White v. Dunbar, 119 U.S. 47, 52 19

Williams Manufacturing Co. v. United Shoe Machinery Corp., 316 U.S. 364, 365 9

Statutes

Judicial Code, Sec. 24(7); 28 U.S.C. 41(7) 11

Judicial Code, Sec. 240(a) as Amended, 28 U.S.C. 347 11

Sec. 4888, R.S.; U.S.C. Title 35, Sec. 33 18

Textbook

Walker on Patents, Deller's Ed., Vol. II, Sec. 274, Page 1271 16

Rule

Rule 38 1

IN THE

SUPREME COURT OF THE UNITED STATES

OCTOBER TERM, 1945

NO.

THE E. L. ESSLEY MACHINERY COMPANY,
an Illinois Corporation,
Petitioner,

VS.

THE DELTA MANUFACTURING COMPANY,
a Delaware Corporation,
Respondent.

PETITION FOR A WRIT OF CERTIORARI
To the Circuit Court of Appeals
For the Seventh Circuit.

To the Honorable The Chief Justice and the Associate Justices of the Supreme Court of the United States:

Your Petitioner, The E. L. Essley Machinery Company, respectfully prays for a writ of certiorari to the Circuit Court of Appeals for the Seventh Circuit to review a judgment of that Court, entered February 28, 1946 (R. 314). A certified transcript of record, including the proceedings in the Circuit Court of Appeals, has been filed herein pursuant to Rule 38.

I. SUMMARY AND SHORT STATEMENT OF THE MATTER INVOLVED.

This is a suit for the infringement of claims 6, 7 and 8 of Letters Patent No. 2,069,395, dated February 2, 1937 (R. 239), relating to a "safety shield". The District Court held the claims valid and infringed and ordered an injunction and an accounting (R. 221, 308). The Circuit Court of Appeals affirmed (R. 314). A petition for rehearing was filed (R. 317) and denied (R. 331).

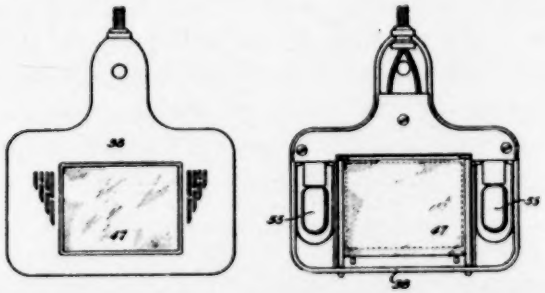
Petitioner concedes infringement if the claims are valid. **Petitioner does not seek a retrial of the facts, merely a proper application of the law to the facts.**

The Gravamen: Having regard to the alleged **invention defined in the claims** of the patent in suit, both decisions and all findings below are utterly irrelevant and fail to support the ultimate conclusions of invention and validity. **There is no correspondence between the invention claimed and the facts found.**

The patented device, *as defined by the claims,* is a safety shield or viewing device comprising a frame or housing having a central opening therein, a transparent panel for the opening, lamp compartments adjacent opposite sides of the transparent panel, and lamps in the compartments. The patent points out that the lamps adjacent opposite sides of the transparent panel afford "shadowless illumination" of work viewed therethrough. The prior art contains viewing devices which squarely anticipate the claims. These prior art devices have all of the claimed elements arranged and functioning in precisely the same way and producing precisely the same result. The claims read squarely upon them. In substance they are identical.

The courts below disregarded the plain language of the claims and interpreted them as including elements not recited therein, namely, a grinding machine and a special mounting of the viewing device thereon in relation to the grinding wheel thereof. They considered the advantages which existed only when the shield was so mounted and employed, and relying on those advantages brushed aside the prior art and held the claims valid. Thus there was upheld as an invention a relationship between a grinding wheel and an illuminating viewing device which relationship was neither claimed nor patented. This is contrary to and in direct conflict with the settled law of this Court. It also works hardship and injury to the public, for the patent will not expire until February, 1954.

The Alleged Invention: Two illustrations of the device of the patent are reproduced at this point, a top view (left), and an inverted view (right), the parts indicated by reference numerals being specified in the footnote[1]:



While the patent discloses an application of the device to a grinding machine, the patentee in his specification states (R. 240, 2nd col. ls. 52-4), "While the safety shield

[1] 38—housing or support; 47—transparent viewing panel or window; 55—lamps beneath housing, one on either side of window.

is here shown to be applied to a grinder it may also be applied to other machines or devices", and the claims contain no recital or reference of any kind or nature to a grinding machine or to the combination of the device with or the mounting or application thereof to or upon a grinding machine. Furthermore, Respondent has granted a license under the patent under which the licensee makes and sells the shield to dentists, dermatologists and surgeons (R. 203-5) for uses having no relation whatever to grinding.

The claims in suit recite "a safety shield comprising a housing" (claim 6), or "a safety shield comprising a support" (claims 7 and 8) having a transparent viewing panel or window, lamps beneath the housing or support, one on either side of the window. Claim 6 is typical.[2]

A shield comprised of these elements constitutes the whole of the alleged invention as set forth in the claims.

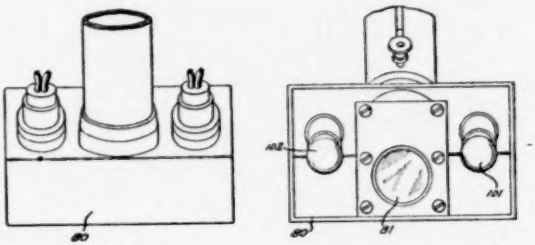
The Prior Art: The use of two or more lamps in shields or viewing devices to provide shadowless illumination of an object or work viewed through a central window in the top wall of the device was old in the art long prior to the alleged invention of the patent in suit.

Following are two views of one of these prior art shields (Jones R. 289), a top view (left), and an inverted view (right), the parts indicated by reference

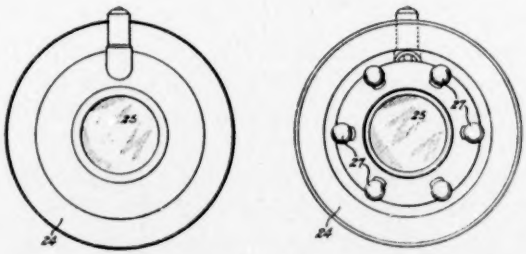
---

[2] 6. A safety shield comprising a housing having a top wall and a skirt, said top wall having an opening, a transparent panel for said opening for viewing work therethrough, and means carried by said housing for directing light onto the work from regions adjacent the opposite sides of said panel and within said skirt.

numerals being specified in the footnote[3]:



Two views of another of these prior art shields (Lindsay R. 297) are reproduced at this point, a top view (left), and an inverted view (right), the parts indicated by reference numerals being specified in the footnote[4]:



The device of the patent is a substantial copy of these prior art shields. In substance they are identical. In the Jones shield two lamps are employed, one on each side of the viewing panel affording shadowless illumination of an object or work viewed through the device. In Lindsay six lamps are mounted in the shield and spaced equidistantly around the viewing opening to provide the shadowless illumination.

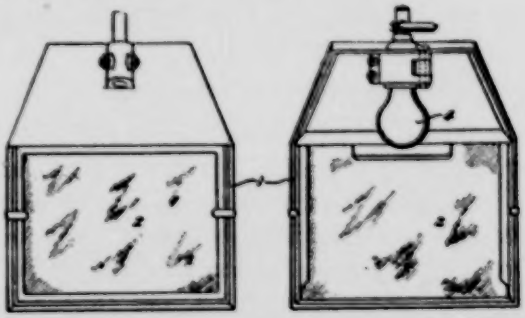
---

[3] 80—housing or support; 81—transparent viewing panel or window; 101, 102—lamps beneath the housing, one on either side of window.

[4] 24—housing or support; 25—transparent viewing panel or window; 27—lamps beneath housing entirely surrounding window.

The Jones shield is shown applied to a cutting machine. The Lindsay shield is not shown applied to any particular use or machine, but the patent (R. 297, ls. 7-10) states: "the present invention is especially adapted for use by mechanics, watch makers, and artisans of various kinds where fine work is involved," and (R. 298, ls. 129-131) "that others can by applying current knowledge readily adapt it for various applications."

It was also old in the art long prior to the alleged invention of the patent in suit to mount on grinding machines safety shields of the precise character and construction set forth in the patent in suit with the single exception that in these earlier grinding wheel safety shields a lamp on but one side of the viewing window was employed (R. 163-179, incl.). Two views of one of these prior art safety shields (Boys Tech. R. 179) are reproduced at this point, a top view (left), and an inverted view (right), the parts indicated by reference numerals being specified in the footnote[5]:



Save for the second lamp on the opposite side of the viewing window, this safety shield embodies every element of the claims in suit.

[5] 1—housing or support; 2—transparent viewing panel or window; 4—lamp beneath housing on one side of window.

Not a single item of this prior art is in dispute. The disclosures are clear and unequivocal.

The Findings and Decisions of the Courts Below: The Court of Appeals made no analysis of the claims in suit, but treated them throughout as though they included or were directed to the combination of the shield with a grinding machine which is entirely foreign to the combination or structure defined by the claims. The Court pointed out at length (R. 310) the rigidity of the mounting of the shield upon a grinding machine to avoid vibration, the positioning of the light bulbs at the sides of the shield out of the line of particles thrown off from the grinding wheel, the permanent mounting of the shield close to the grinding wheel so that it cannot be thrown back, and then detailed the history of grinding machine shields, the use of goggles, the practice of throwing the old shields back out of the way as compared to the permanent mounting of the shield of the patent. The lower court viewed the matter in the same light and made specific findings (R. 214) concerning the grinding machine adaptation of the device in support of the holding of validity. ***There is nothing in any of the three claims in suit on which to base any such findings. All are entirely foreign to the claims.***

Save for findings relating to such matters as parties, jurisdiction, title, conduct of defense, and the like, and the ultimate findings or conclusions of validity and invention, all facts found and all opinions expressed by the lower courts treat of the invention in terms of grinding.

The Court of Appeals rejected the single lamp safety shields because they incorporate but one lamp (R. 312). It rejected the Jones shield because it is shown applied to a cutting machine (R. 313), despite the fact that the specification of the patent in suit expressly points out

that the shield of the patent is not limited to grinders but may also be applied to other machines and devices, and despite the fact that the claims do not even mention grinding machines or the manner of mounting the support or housing, fixedly or otherwise. The patentee sought and obtained claims to a safety shield for general application or adaptation. The Court rejected the Lindsay device because it employs a transparent panel or window of magnifying glass (R. 313), despite the fact that Respondent's licensee makes and sells under the patent a viewing device (R. 203-5) employing a transparent panel or window of magnifying glass in no way related to the grinding machine art, and further, despite the fact that the claims merely call for a "transparent panel", a term equally descriptive of a window whether of magnifying or plain glass.

II. REASONS RELIED UPON FOR THE GRANTING OF A WRIT OF CERTIORARI.

The discretionary power of this Court is invoked upon the following grounds:

1. Because the decisions of the courts below are contrary to and in direct conflict with the decisions of this Court in *Altoona Publix Theatres, Inc. v. American Tri-Ergon Corp.*, 294 U.S. 477, 487; *Milcor Steel Co. v. George A. Fuller Co.*, 316 U.S. 143, 145; *General Electric Co. v. Wabash Co.*, 304 U.S. 364, 369; *McCarty v. Lehigh Valley R. R. Co.*, 160 U.S. 110, 116; all to the effect that it is the claims, not the specifications, which afford the measure of protection of the grant and that the claims of a patent cannot be aided by reading into them parts of the specifications which the patentee failed to include in them.

2. Because the decisions of the courts below are contrary to and in direct conflict with the decisions of this Court in *Grinnell Washing Machine Co. v. Johnson Co.*, 247 U.S. 426, 433-4; *Powers-Kennedy Contracting Corporation, et al. v. Concrete Mixing and Conveying Co.*, 282 U.S. 175, 180, 186; *Electric Cable Joint Co. v. Brooklyn Edison*, 292 U.S. 69, 79; *Concrete Appliances Co., et al. v. Gomery et al.*, 269 U.S. 177; *American Road Machine Co. v. Pennock and Sharp Company*, 164 U.S. 26; all to the effect that no invention is involved in assembling old elements where the result is only that which arises from the well-known operation of each.

3. Because the courts below have failed to give proper consideration to the public interest in holding claims 6, 7 and 8 of the patent in suit valid and in construing the claims as though they were directed to a grinding machine combination, whereas in fact they are not to such a combination, either directly or indirectly, and the public interest becomes paramount, *Mercoid Corporation v. Mid-Continent Investment Co.*, 320 U.S. 661, 665; *General Electric Co. v. Wabash Appliance Corporation*, 304 U.S. 364, 369; *United Carbon Company v. Binney & Smith Co.*, 317 U.S. 228, 232.

4. Because Petitioner does not seek a retrial of the facts but merely a proper application of the law to the facts, *The Williams Manufacturing Co. v. United Shoe Machinery Corp.*, 316 U.S. 364, 365.

5. Because the validity of an unexpired patent is of public importance, *Sinclair & Carroll Co. v. Interchemical Corp.*, 65 S. Ct. 1143, 1145; 325 U.S. 327.

Wherefore, your Petitioner respectfully prays that a writ of certiorari be issued under the seal of this Court, directed to the United States Circut Court of Appeals

for the Seventh Circuit, commanding the said Court to certify and send to this Court, on a day to be designated, a full and complete transcript of the record and all proceedings of the Circuit Court of Appeals had in this cause, to the end that this cause may be reviewed and determined by this Court, that the judgment of the Circuit Court of Appeals be reversed, and that Petitioner be granted such other and further relief as may seem proper.

JOHN W. MICHAEL,
GERRIT D. FOSTER,
Counsel for Petitioner.

Milwaukee, Wisconsin,
May 15, 1946.

BRIEF IN SUPPORT OF PETITION.

THE OPINIONS OF THE COURTS BELOW.

The opinion of the District Court is unreported (R. 209). The opinion of the Circuit Court of Appeals is reported, 153 Fed. (2d) 905, (R. 310).

JURISDICTION.

This is a suit arising under the patent laws of the United States, JUDICIAL CODE, Sec. 24(7) (28 U.S.C. 41 (7)). The date of the judgment is February 28, 1946 (R. 314). The statute under which jurisdiction is invoked is Section 240(a) of the JUDICIAL CODE (28 U.S.C. 347, as amended). Cases believed to sustain the jurisdiction are *Lincoln Co. v. Stewart-Warner Corp.*, 303 U.S. 545, 546; *Schriber Co. v. Cleveland Trust Co.*, 311 U.S. 211, 217; *Altoona Publix Theatres, Inc. v. American Tri-Ergon Corp.*, 294 U.S. 477, 487; *Morton Salt Co. v. Suppiger Co.*, 314 U.S. 488, 490.

STATEMENT.

The facts, so far as this application is concerned, are stated in the petition.

SPECIFICATION OF ERRORS.

The errors which Petitioner will urge, if the writ of certiorari is granted, are that the Circuit Court of Appeals for the Seventh Circuit erred:

1. In holding claims 6, 7 and 8 of patent 2,069,395 valid.

2. In failing to hold that said claims are invalid because of anticipation and also want of invention.

3. In reading into the claims limitations not included therein and which the patentee expressly stated should not be read into them.

4. In not following the decisions of this Court on the questions of anticipation, invention, and claim interpretation.

5. In ascribing functions and results to the combination of the claims entirely foreign to the combination of elements recited in the claims.

SUMMARY OF ARGUMENT.

The summary of argument is set forth in the petition under reasons 1, 2 and 3 relied upon for the allowance of the writ, and, for the sake of brevity, are not repeated at this point.

ARGUMENT.

I. It is the claims of a patent which define and measure the invention and the claims here being fully and squarely anticipated by the prior Jones and Lindsay viewing devices cannot be saved by reading into them parts of the specifications which the patentee not only failed to include in them but expressly stated were not to be included. In *Altoona Publix Theatres, Inc. v. American Tri-Ergon Corp. et al.*, 294 U.S. 477, this Court stated at page 487:

> "The Court of Appeals, in upholding the patent, made no examination of its separate claims, but treated the patent throughout as though it were a combination of five distinct elements, the photoelectric cell, the arcuate flexing of the film, the flywheel,

> the flexible connection of the flywheel and the optical slit, although nowhere in the patent is any such combination claimed. The patent thus upheld is one which was neither claimed nor granted. Under the statute it is the claims of the patent which define the invention. See *White v. Dunbar,* 119 U.S. 47, 51, 52; *McClain v. Ortmayer,* 141 U.S. 419, 423-425; *The Paper Bag Patent Case,* 210 U.S. 405, 419; *Smith v. Snow, ante,* p. 11. And each claim must stand or fall, as itself sufficiently defining invention, independently of the others. See *Carlton v. Bokee,* 17 Wall. 463, 472; *Russell v. Place,* 94 U.S. 606, 609; *Leeds & Catlin Co. v. Victor Talking Machine Co.,* 213 U.S. 301, 319; *Symington Co. v. National Malleable Castings Co.,* 250 U.S. 383, 385; *Smith v. Snow, supra;* Walker on Patents, Sec. 220, 6th Ed. As none of the flywheel claims as drawn define an invention, none can be aided by reading into it parts of the specifications, or of other claims, which the patentees failed to include in it."

And in *McCarty v. Lehigh Valley R. R. Co.,* 160 U.S. 110, 116, this Court stated:

> "We know of no principle of law which would authorize us to read into a claim an element which is not present, for the purpose of making out a case of novelty or infringement."

To the same effect are the decisions of this Court in the other cases cited in the petition under the first of the reasons relied upon for the allowance of the writ.

In *Milcor Steel Co. v. George A. Fuller Co.,* 316 U.S. 143, there was an attempt to revise by disclaimer the claims of the patent there in suit by adding an element from the specification but not included in the claims as granted. This Court condemned such procedure stating (316 U.S. 145-6):

"As the courts below pointed out, it is these claims, not the specifications, that afford the measure of the grant to the patentee. 'Out of all the possible permutations of elements which can be made from the specifications, he reserves for himself only those contained in the claims.' 122 F. 2d 292, 294. The foregoing features appearing in the specifications are not set out in the claims themselves; the claims do not indicate in any way that these features were essential parts of the combination for which the patent was issued. On the contrary, Holdsworth asserted that his specifications in general showed only a 'preferred embodiment' of his invention, and with respect to the ceiling member in particular, stated: 'I do not wish to be limited to an angle iron for completing the top of the metal construction.'

"The disclaimers, however, purported to make these two features essential parts of the claimed combination. * * * Limiting ourselves, as we must, to the original claims to determine the nature of the combination covered by the patent when it was granted, and comparing that combination with the one purportedly embodied by the claims after the disclaimer, we can only conclude that the revised patent includes new elements which were not present in the original."

If such claim revision is invalid under disclaimer procedure, it follows, we think, that any such revision by judicial interpretation must likewise be invalid.

Petitioner is not unmindful of and has no quarrel with the rule and authorities to the effect that the specification and drawings of a patent may be referred to as an aid in construing what is set forth in the claims. The courts below have gone far beyond that in this case. *Here recourse has been had to the specification not for the purpose of construing what is set forth in the claims but for*

the purpose of revising the claims to include elements not present therein.

The Jones and Lindsay patents do not specifically mention the application of their viewing devices to grinding machines, but no such combination is set forth in the claims in suit. The invention defined in the claims is a viewing device *per se* susceptible of many different uses and applications and is so described in the specification, (R. 240, 2nd col. ls. 52-54) and the Jones and Lindsay devices are likewise viewing devices and are likewise susceptible of many different uses and applications and are so described.[6] The lack of specific mention in the Jones and Lindsay patents of use of their viewing devices as shields on grinding machines in no way impairs their anticipatory significance, for under long established authority of this Court it is not invention to use an old device for a new and analogous purpose. (*Roberts v. Ryer*, 91 U.S. 150, 157; *Phillips v. Page*, 24 How. 164, 167; *Pennsylvania Railroad Company v. Locomotive Truck Co.*, 110 U.S. 490, 494-496; *Ansonia Co. v. Electrical Supply Co.*, 144 U.S. 11, 18; *Potts v. Creager*, 155 U.S. 597, 608; *Dow v. Halliburton*, 65 S. Ct. 647, 650; 324 U.S. 320; *Cuno Engineering Corporation v. Automatic Devices Corp.*, 314 U.S. 84, 91). The prior art in the instant case teaches and contains many examples of the use of viewing devices as shields on grinding machines (R. 139, 147, 163, 165, 167, 169, 171, 173, 175, 177, 179, 252, 258, 270, 276, 280).

Furthermore, the introductory phrase "a safety shield" of the claims in suit merely states the intended purpose

---

[6] See specification of Lindsay patent R. 297, ls. 8-10, "use by mechanics, watch makers, and artisans of various kinds where fine work is involved," and R. 298, ls. 128-131, "the foregoing will so fully reveal the gist of this invention that others can by applying current knowledge readily adapt it for various applications."

or use of the device and imports nothing in the way of structural elements into the claims. (*Ford Motor Co. v. Parks & Bohne*, C.C.A. 6th, 21 Fed. (2d) 943, 946, citing *McCarty v. Lehigh Valley R. R. Co.*, 160 U.S. 110, 116, and then Circuit Judge Taft in *Stearns v. Russell*, C.C.A. 6th, 85 Fed. 218, 224, certiorari denied 171 U.S. 689; *Grosjean et al v. Panther-Panco Rubber Co., Inc.*, C.C.A. 1st, 113 Fed. (2d) 252, 256; *Hookless Fastener Co. v. G. E. Prentice Mfg. Co.*, C.C.A. 2nd, 68 Fed. (2d) 940, 941; *Walker on Patents, Deller's Ed.*, Vol. II, Sec. 274, Page 1271.)

II. Assuming that failure of Jones and Lindsay to make specific reference to use of their viewing devices on grinding machines deprives those devices of technical responsiveness to the introductory term "safety shield" used in the claims in suit, the claims are nevertheless invalid for want of invention.

The gist of the alleged invention was the use in the old grinding wheel safety shields (R. 135, 163-179, incl., 276) of two lamps instead of one to provide shadowless illumination also old in the prior art (R. 183, 185, 187, 189, 248, 288, 296). The Court of Appeals stated (R. 312):

> "Each of these disclosures (single lamp safety shields) of prior art has but a single light, and for that reason neither affords shadowless illumination of the wheel and work when viewed through the shield."

To incorporate the second lamp in these old single lamp safety shields to afford shadowless illumination was utterly devoid of invention in view of the prior use in the Jones and Lindsay devices of two or more lamps for precisely that very same purpose.

The Lindsay patent contains a clear and unequivocal disclosure and description of shadowless illumination in

a viewing device (R. 297, ls. 38-42; 58-62; R. 298, ls. 27-31, 106-114), and shadowless illumination was common everyday practice in almost every conceivable industry and art, as for example shaving mirrors, dressing tables, show windows, display cases, stage lighting, surgery, compasses (R. 248), machine tools (R. 183-189. incl.) etc. No new result or function was therefore evolved from the addition of the second lamp to provide shadowless illumination in the old and well-known single lamp safety shields.

As was stated by this Court in *Grinnell Washing Machine Co. v. Johnson Co.*, 247 U.S. 426, after reviewing the earlier decisions of this Court (pages 433, 434):

> "Applying the rule thus authoritatively settled by this Court, we think no invention is shown in assembling these old elements for the purposes declared. *No new function is 'evolved from this combination'; the new result, so far as one is achieved, is only that which arises from the well-known operation of each one of the elements.*
>
> "In the gearing specified every element is old. The operations of the wringer and the washing machine, although simultaneous, are independent one of the other. The control of the operation of the wringer is by an old and well-known method. *From the co-operation of the elements, here brought together no new result, involving the exercise of the creative faculty which is invention, is achieved.*"

Applying this test to the elements of the claims in suit, it cannot fairly be denied that the shield merely performs the old and well-known function of a shield and the two lamps, the old and well-known function of shadowless illumination. The operations of these elements, although simultaneous, are independent one of the other. The only result achieved is that which "arises

from the well-known operations of each one of the elements", and "no new function is 'evolved from this combination.'"

As this Court also said in *Powers-Kennedy Contracting Corporation, et al. v. Concrete Mixing and Conveying Co.*, 282 U.S. 175, 186:

> "For these reasons we find that the patent is invalid. It consists of a combination of elements all of which were old in the art. Its application to the transportation of concrete did not involve invention. Neither the combination of old elements or devices accomplishing no more than an aggregate of old results (*Hailes v. Van Wormer*, 20 Wall. 353; *Office Specialty Mfg. Co. v. Fenton Metallic Mfg. Co.*, 174 U.S. 492; *Grinnell Washing Machine Co. v. E. E. Johnson Co.*, 247 U.S. 426) nor the use of an old apparatus or appliance for a new purpose (*Roberts v. Ryer*, 91 U.S. 150), is invention."

Also, as said by this Court in *Electric Cable Joint Co. v. Brooklyn Edison*, 292 U.S. 69, 79, the addition made by the patentee—

> "must be the result of invention, not the mere exercise of the skill of the calling and *not one plainly indicated by the prior art.*"

III. As a prerequisite to the grant of a patent, Congress has required that the patentee "distinctly claim the part, improvement or combination which he claims as his invention," (Sec. 4888, R.S.; U.S.C. Title 35, Sec. 33). As we have shown, the claims here in suit drawn in compliance with this statutory requirement read squarely upon and are anticipated by the prior art. To hold such claims valid by rewriting, revising or interpreting them to include elements not recited by them is to overlook the public interest, for the public has the right to rely upon the claims as granted, and if as granted they

encroach upon the public domain they are invalid and unenforceable.

In *White v. Dunbar,* 119 U.S. 47, 52, this Court stated:

> "The claim is a statutory requirement, prescribed for the very purpose of making the patentee define precisely what his invention is; and it is unjust to the public, as well as an evasion of the law, to construe it in a manner different from the plain import of its terms. This has been so often expressed in the opinions of this court that it is unnecessary to pursue the subject further. See *Keystone Bridge Co. v. Phoenix Iron Co.,* 95 U.S. 274, 278; *James v. Campbell,* 104 U.S. 356, 370."

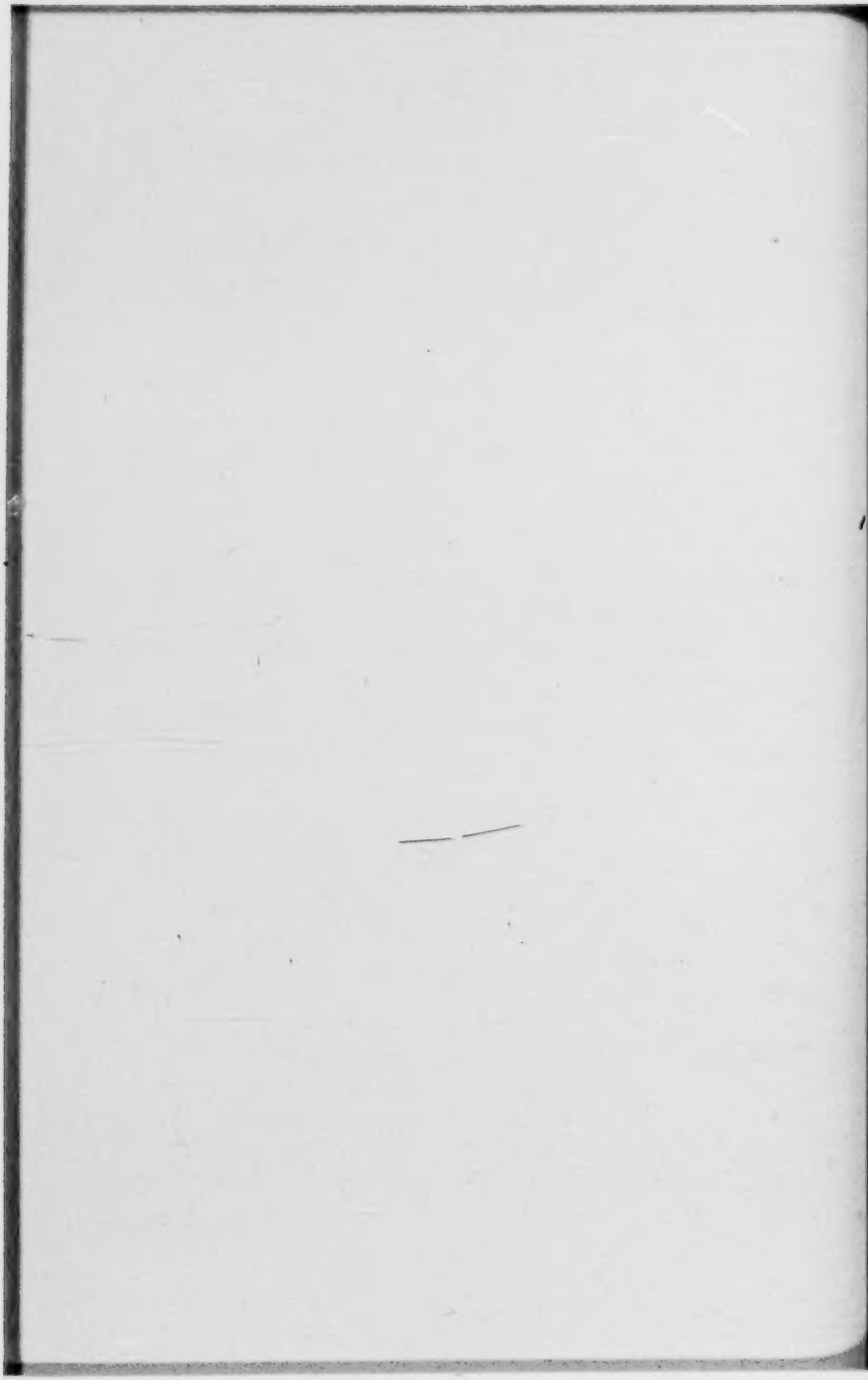
And in *Mercoid Corp. v. Mid-Continent Investment Co.,* 320 U.S. 661, 665, this Court stated:

> "It is the public interest which is dominant in the patent system."

The decisions of the courts below are in conflict with the applicable decisions of this Court and should be overruled.

Respectfully submitted,

JOHN W. MICHAEL,
GERRIT D. FOSTER,
Counsel for Petitioner.



22

FILED
JUN 7 1946
CHARLES ELMORE CROPLEY
CLERK

IN THE

Supreme Court of the United States

OCTOBER TERM, 1945.

No. 1233.

THE E. L. ESSLEY MACHINERY COMPANY, an Illinois Corporation, *Petitioner*,

v.

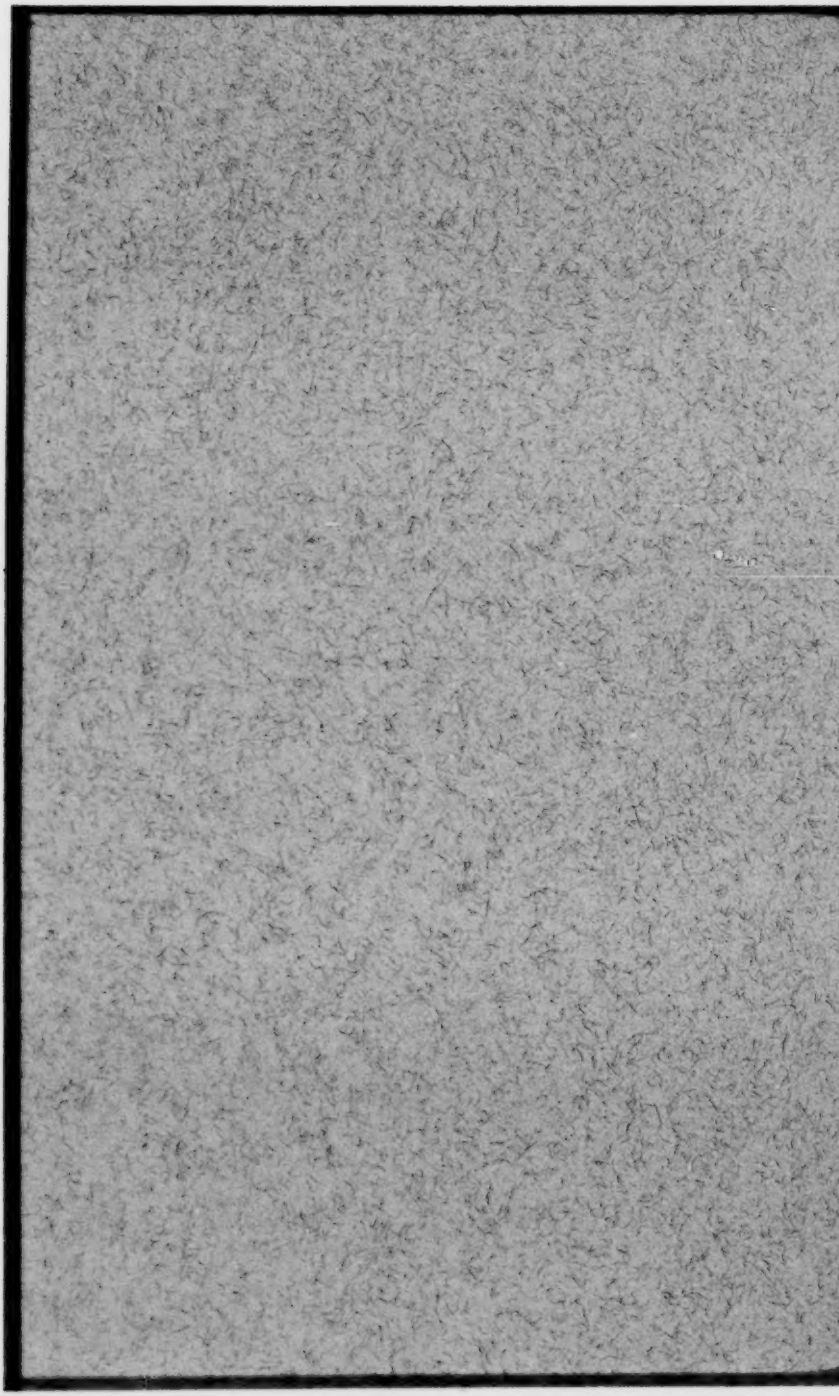
THE DELTA MANUFACTURING COMPANY, a Wisconsin Corporation, *Respondent*.

RESPONDENT'S BRIEF IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI TO THE CIRCUIT COURT OF APPEALS FOR THE SEVENTH CIRCUIT.

WILLIAM A. STRAUCH,
Counsel for Respondent.

J. MATTHEWS NEALE,
STRAUCH & HOFFMAN,
Of Counsel.

PRESS OF BYRON S. ADAMS, WASHINGTON, D. C.



INDEX.

	Page
Opinions Below	1
Jurisdiction	1
Questions Presented	2
Supplement to Statement of the Case	2
Summary of Argument	6
Argument	7
Point 1	7
Point 2	9

CITATIONS.

Altoona Publix Theatres, Inc. v. American Tri-Ergon Corp., 294 U. S. 477, 487 ..... 2, 6
Benoit v. Wadley Co., 54 F. (2d) 1041, 1044 ..... 6, 8
The Corn Planter Patent, 90 U. S. (23 Wall.) 181, 218.. 6, 8
Goodyear Tire & Rubber Co. v. Ray-O-Vac Co., 321 U. S. 275, 279 ..... 7, 11
Lincoln Co. v. Stewart-Warner Corp., 303 U. S. 545, 546 ..... 2, 6
Morton Salt Co. v. Suppiger Co., 314 U. S. 488, 490 .... 2, 6
Paramount v. Tri-Ergon Corp., 294 U. S. 464, 474 ..... 7, 11
Schram Glass Mfg. Co. v. Homer Brooke Glass Co., 263 F. 903 ..... 6, 8
Schriber Co. v. Cleveland Trust Co., 311 U. S. 211, 217 . 2, 6
Seymour v. Osborne, 78 U. S. (11 Wall.) 516, 547 ..... 6, 8
Westinghouse v. Boyden, 170 U. S. 537, 557, 558 ..... 6, 8

IN THE

Supreme Court of the United States

OCTOBER TERM, 1945.

No. 1233.

THE E. L. ESSLEY MACHINERY COMPANY, an Illinois Corporation, *Petitioner*,

v.

THE DELTA MANUFACTURING COMPANY, a Wisconsin Corporation, *Respondent*.

RESPONDENT'S BRIEF IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI TO THE CIRCUIT COURT OF APPEALS FOR THE SEVENTH CIRCUIT.

Opinions Below.

The opinion of the District Court of the United States for the Eastern District of Wisconsin (R. 209-214) is not reported. The opinion of the Circuit Court of Appeals (R. 310-314) is reported, 153 Fed. (2d) 905.

Jurisdiction.

The order of the Circuit Court of Appeals (R. 314) affirming the decree of the District Court (R. 220) was entered on February 28, 1946, and defendant's petition for re-hearing (R. 315-324) filed on March 14, 1946, opposed by plaintiff (R. 327-330) was denied by the order of the Circuit Court of Appeals (R. 331) entered April 3, 1946. The peti-

tion for a writ of certiorari was filed on May 16, 1946. Jurisdiction of this Court is invoked under Section 240(A) of the Judicial Code (28 U. S. C., 347, as amended) and the cases of *Lincoln Co.* v. *Stewart-Warner Corp.*, 303 U. S. 545, 546; *Schriber Co.* v. *Cleveland Trust Co.*, 311 U. S. 211, 217; *Altoona Publix Theatres, Inc.* v. *American Tri-Ergon Corp.*, 294 U. S. 477, 487; and *Morton Salt Co.* v. *Suppiger Co.*, 314 U. S. 488, 490.

Questions Presented.

The questions presented are whether the courts below properly held claims 6, 7 and 8 of patent 2,069,395 valid and whether the courts below improperly interpreted the claims in suit by ascribing functions and results to the claimed combination entirely foreign to the combination of elements recited in the claims in denying anticipation and want of invention with respect to the claimed invention in suit.

Supplement to Statement of the Case.

Petitioner's statement of the case concedes infringement, if the claims are valid, and purports to seek a proper application of the law to the facts as distinguished from a retrial of the facts. Accordingly, it is respectfully submitted that the following fact findings of the District Court, affirmed by the Court of Appeals, are conceded by defendant and although omitted from petitioner's statement of facts we submit should be considered. These facts are:

The District Court found, from the testimonial and documentary evidence introduced at the trial, that the need for transparent shields to protect grinder operators was recognized and an attempt at solution was made as early as 1767 (F.* 7 R. 214, 215). This fact finding is fully substantiated by the trial evidence. (PX** 5 R. 44, 104, 105 and 125.)

The Court found further that prior efforts to solve the problems encountered in providing a satisfactory grinder

---

* Refers throughout to District Court's Findings of Fact.

** Refers throughout to Plaintiff's Exhibit.

safety shield had been made and resulted in failure to satisfy the art, (F. 8. R. 215). This finding likewise is fully supported by the documentary and testimonial evidence introduced at the trial. (PX 4B, 4C, 9B, 17 and 18, R. 256, 276, 147, 159, and 161 respectively; DX*-A to C-3, G, H, J, N and O, R. 163 to 179, 252, 270, 280, 191 and 193 respectively; the testimony of plaintiff's witnesses Doyle, R. 14 to 20; Melius, R. 30, 31; Martin, R. 36; Heinrich, 39, 41; Wiken, R. 43, 44, 47, 56, 57, 73, 112-122; Rasmussen, R. 105-107, 109-111; and Defendant's own witnesses Bernitt and Mickelson, DX-N, R. 191-193.)

Defendant's own expert, McNulty, chose the single bulb Surty shield, (PX-9B, R. 147, DX-A), the Acme single bulb shield made under patent 1,633,412 to Kelleher (PX-4c and PX-6, R. 276, 129) and the Boys Tech shields (DX-C and DX-C^1 to DX-C^3, R. 175-179) as the closest prior art to the patent in suit and the Lindsay and Jones patents 1,960,114 (DX-L, R. 296) and 1,952,073 (DX-M, R. 284) as the closest patented art (R. 94, 95). The District Court found, among other things, that the single bulb Surty shields, the Boys Tech shields, and the Acme single bulb shields of patent 1,633,412, did not satisfactorily supply this need and were among the prior efforts and failures to solve the problems overcome by the Tautz patent in suit. (F. 8., R. 215). The District Court also found that the viewing devices of Lindsay patent 1,960,114 and Jones patent 1,952,073 could not be used as grinder safety shields and do not suggest the safety shield of Tautz patent 2,069,395 in suit (F. 9, R. 215). This finding is amply supported by the testimony adduced at the trial. In this connection defendant's own witness Bernitt said: (Paragraph 3 of DX-N, R. 191):

> "* * * In these Surty shields if the light is back too far, there is a shadow cast on the wheel, the work support, and the work by the wheel and wheel housing, and if the shield is moved forward to eliminate the shadow, it brings the glass so far forward that it is

* Refers throughout to Defendant's Exhibit.

> difficult to see the wheel without getting into an awkward position which makes it dangerous."

The awkward position referred to is well illustrated by PX-17 (R. 159).

The Surty Company who manufactured the Surty single bulb shields as early as 1923, and about 1926 undertook to sell the Acme shields made under the Kelleher patent 1,633,412, characterized the single bulb shield as inadequate in lighting, saying (PX-9B, R. 147):

> "In 1923, the shield to the left was the first successful illuminating SHIELD (called a Machine Goggle). It protected the face but was inadequate in lighting. Many and varied have been the steps of improvement until the E-Z Vision SHIELD on the right has been developed."

In speaking of the Jones and Lindsay patents, defendant's expert, McNulty, admitted that only an image of the actual object could be viewed through the structure of the Jones patent after it had been properly focused (R. 99), that many of the parts of the Jones structure would be unnecessary and should be discarded in adapting it to a grinder (R. 99, 100), that the magnifying glass of the Lindsay patent would distort the object as moved toward or away from the lens (R. 100), and that Lindsay disclosed a focusing of the light rather than mere balancing of light, as is done in the patented and accused structures (R. 101). From this evidence and the testimony of plaintiff's witnesses (R. 15, 18 to 20, 72, 73, 106 to 122), the Court found as a fact that no patent or publication, or prior use, or prior knowledge relied upon, made of record or proven in this cause shows or suggests a grinder shield capable of accomplishing all the desirable new results of finding 24 (F. 28, 29 and 30, R. 218).

The District Court also found that the viewing devices of Lindsay, 1,960,114 and Jones 1,952,073, and the single bulb Surty shields, the shields made at Boys Tech and the Acme shields made under the Kelleher patent 1,633,412, among

many other prior art patents relied upon, do not embody or suggest the teachings of claims 6, 7 and 8 of the Tautz patent in suit (F. 21, R. 216) and that no patent or publication, or prior use or prior knowledge relied upon, made of record or proven in this cause, shows or suggests the grinder shield embodying the structure defined by claims 6, 7 and 8 in suit (F. 25, 26, 27, R. 218). The evidence produced at the trial fully substantiates these findings (R. 14-20, 30, 31, 36, 39, 41, 43, 44, 47, 56, 57, 73, 112-122, 105-107, 109-111 and DX-N, R. 191-193) and the Court of Appeals affirmed these findings and the District Court's conclusions as shown by its opinion (R. 310 to 314), the wording of which clearly indicates a careful consideration of the testimonial and documentary evidence adduced at the trial.

The "Twin-Lite" safety shield made pursuant to Tautz patent 2,069,395 in suit, achieved commercial success through acceptance by mechanics, engineers and those skilled in the art on merit, and was not the result of any unusual advertising campaign (F. 20, R. 216) and its success was such that the Surty Company, manufacturers and vendors of the prior single-bulb shields of DX-A to AB-1 heavily relied upon by defendant, adopted and placed a two bulb shield substantially embodying the structure of the Tautz patent upon the market in 1937, accepted a license under the Tautz patent on June 27, 1938, and has been paying royalties ever since, (F. 16, R. 24, 25, 143, 216). The Boyer-Campbell Company, who make safety shields as well as inspection or examination devices for dentists, dermatologists and surgeons as asserted at page 4 of petitioner's petition for certiorari, took a license under the patent on September 30, 1942, and since that date has paid royalties on the grinder shields made by it (F. 17, R. 24, 25, 143, 216). It is significant, regarding this license, that royalties are paid on the sales of safety shields only as distinguished from the "medical gadget." (R. 28).

It is further shown that this commercial success was achieved by a small company in bad business times, without substantial advertising, in the face of low cost, national

chain store competition such as Sears Roebuck, Western Auto Supply and others, and in spite of the fact that plaintiff's "Twin-Lite" safety shields added substantially to the cost of the grinders and were introduced at relatively high prices as compared to the low-cost chain store competition. (F. 14, R. 31, 32, 37, 143, 215). As a matter of fact 25% of respondent's production of shields developed from use on grinders for which they were not designed and to which they had to be specially fitted by the purchasers. (R. 32, 37).

Summary of Argument.

Point 1. The special circumstances recognized by this court for exercising its jurisdiction under Section 240(a) of the Judicial Code (28 U. S. C. 347, as amended) in patent cases in the absence of diversity of opinion as to validity in the Courts of Appeals are not present in this case, there being a complete absence of the reading of an element into any claim in suit, and, therefore, the cases of *Lincoln Co.* v. *Stewart-Warner Corp.*, 303 U. S. 545, 546; *Schriber Co.* v. *Cleveland Trust Co.*, 311 U. S. 211, 217; *Altoona Publix Theatres, Inc.* v. *American Tri-Ergon Corp.*, 294 U. S. 477, 487; and *Morton Salt Co.* v. *Suppiger Co.*, 314 U. S. 488, 490, do not sustain jurisdiction of this cause as contended by petitioner.

Seymour v. *Osborne*, 78 U. S. (11 Wall.) 516, 547;
The Corn Planter patent, 90 U. S. (23 Wall.) 181, 218;
Westinghouse v. *Boyden*, 170 U. S. 537, 557, 558;
Benoit v. *Wadley Co.*, 54 F. (2d) 1041, 1044;
Schram Glass Mfg. Co. v. *Homer Glass Co.*, 263 F. 903.

Point 2. The claims in suit specifically call for "A safety shield" and this expression used in each of the claims in suit fully justified the lower courts' reference to the specifications and drawings and consideration of the testimony as to the accomplishments and problems present in providing a satisfactory safety shield for grinders and other cutting machines requiring protection of the worker from flying sparks and particles in order to properly construe the

claims in suit and to apply the various criteria of invention repeatedly approved by this Honorable Court in determining the presence of invention.

Goodyear Tire & Rubber Co. v. *Ray-O-Vac Co.*, 321 U. S. 275, 279.
Paramount v. *Tri-Ergon Corp.*, 294 U. S. 464, 474.

Argument.

Point 1. In an effort to show that this case is outside of the general rule that the Supreme Court will not grant certiorari in patent cases in the absence of diversity of opinion between the Circuit Court as to the validity and infringement of the patent involved, petitioner asserts that the District Court and the Circuit Court of Appeals had recourse to the specifications "not for the purpose of construing what is set forth in the claims, but for the purpose of revising the claims to include elements not present therein" (Page 14 of the petition and argument) and that "The Court of Appeals made no analysis of the claims in suit, but treated them throughout as though they included or were directed to the combination of the shield with a grinding machine which is entirely foreign to the combination or structure defined by the claims." (Page 7 of the petition and argument).

While petitioner, at various points, asserts the Lower Courts' decisions interpret the claims as including elements not recited therein, namely a grinding machine and a special mounting of the safety shield thereon in relation to the grinding wheel, petitioner nowhere points out language of either of the Lower Courts, which is susceptible of such an interpretation of their decisions. This, we submit, is significant since the claims in suit, as well as the specifications, clearly call for "A safety shield" and the specification clearly defines the invention as a "safety shield for grinders" etc. and a device "which will effectively guard a user of a grinding wheel from flying particles and afford shadowless illumination of the wheel and work viewed through the shield." (R. 239, col. 1, lines 1 to 6). In de-

scribing the use of this shield, the very factors which the evidence shows resulted in solution of the problems in the safety shield art are briefly set forth in the patent specification (R. 240, col. 2, lines 29 to 47). This description itself clearly indicates that the solution of the safety shield problems resulted from the arrangement of the elements of the shield, not a particular mounting arrangement on a grinder, and the evidence regarding the unsuccessful (F. 8, R. 14, 16, 31, 36, 39, 41, 43, 215) prior art safety shields provided with universal mounting to secure every conceivable association merely emphasizes this fact.

While it seems clear from the facts that the clause "A safety shield" limits the scope of the claimed invention and, as a corollary, the available prior art, to devices capable of functioning as a safety shield and thus requires, as the courts below did, a consideration of the history of the safety shield art, the inadequacy of the prior art safety shields and viewing devices in solving the problems of the safety shield art, and the adequacy and commercial success of the patented structure as a safety shield in determining the validity of the claims in suit. Ample authority for so doing is found in the following decisions which, in view of the similar fact situations, distinguish this case from those decisions relied upon by petitioner in support of its petition. Ample authority for giving effect to the words "A safety shield" and referring to the specifications to determine the true invention and validity of the claims is found in this Honorable Court's decisions in *Seymour* v. *Osborne*, 78 U. S. (11 Wall.) 516, 547; *The Corn Planter Patent*, 90 U. S. (23 Wall.) 181, 218 and *Westinghouse* v. *Boyden*, 170 U. S. 537, 557, 558. While the foregoing cases do not specifically relate to the effect of an introductory clause as determining the meaning and scope of the claimed invention in sustaining the validity of the patent claims, the Seventh Circuit Court of Appeals decisions in *Benoit* v. *Wadley Co.*, 54 F. (2d) 1041, 1044 and *Schram Glass Mfg. Co.* v. *Homer Brooke Glass Co.*, 263 F. 903, we submit, applied the principles announced in the above mentioned deci-

sions of this Honorable Court by giving effect to the introductory clauses of claims.

It, accordingly, is respectfully submitted that the lower courts in this case properly applied the law to the undisputed facts of this case and that the facts so differ from those in the cases relied upon by petitioner as to render them inapplicable in the present cause.

Point 2. While petitioner's argument in support of its petition for certiorari attempts to belittle the criteria considered by the courts below in upholding the validity of the patent in suit, it is submitted that the lower courts properly held that the invention and the inventor's claimed protection relates to the safety shield art and properly read the combination of elements defined by the claims in suit in the light of the safety shield art and its history. Reference to the evidence adduced at the trial shows that the art of grinder safety shields dates back at least to the year 1767, when the familiar glass screen or panel was adopted by the French, (PX-5, R. 125), and that up until the patent in suit was offered on the market in 1935 a satisfactory grinder shield had never been offered to the trade. (F. 7, 8, 9, 10; R. 214, 215; Testimony R. 14-20, 30, 31, 36, 39-41, 43, 44, 47, 56, 57, 73, 105-107, 109-122, and DX-N, R. 191-193.) This long felt want and crying need was recognized in the patented art since at least February, 1897 (DX-G, R. 252) and an unsuccessful effort was made as early as 1923 to solve the problems with a lighted shield by the manufacturers of the prior art single bulb Surty shield relied upon by petitioner (PX-9B, R. 147). In addition, it is clear that the millions of mechanics who use grinding machines almost daily and who were subject to injuries, painful and frequently serious or fatal, knew these problems from at least the year 1767 but failed to solve them.

Furthermore, the technical staff of the Boys Tech High School in Milwaukee, including shop instructors and technical professors, such as petitioner's own witnesses Bernitt and Mickelson, and plaintiff's witness Rasmussen were

familiar with the problems and disadvantages of the best prior art shield, the single light Surty shield which they had in use, tried to improve it and the best they could produce were the single light Boys Tech shields of DX-C to DX-C-3 which also failed to solve the problems and to fill the long felt want of at least 150 years (R. 175-179, DX-N, R. 191-193). The evidence clearly shows that these various single light shields were unsatisfactory, unsuccessful and impractical, and that the illuminated viewing devices known to the art since 1896 (DX-K, R. 248) including the Mitchell patent 565,011, Lindsay patent 1,960,114 and Jones patent 1,952,073, could not be used as grinder shields without substantial alterations of the means disclosed (R. 14-20, 30, 31, 36, 39, 41, 43, 44, 47, 58, 73, 99-101, 105-107, 109-122) and that these prior devices do not disclose the construction of the patent in suit (R. 15, 30-33, 37, 39, 40, 42, 43, 44, 47, 64, 71, 106-109). In view of this testimony the court, properly we submit, held that the transparent shields of patents 596,762 to Sevison, 1,259,050 to Schofield, 1,759,941 to Frey (DX-G to DX-J R. 189, 252, 270) the single bulb Surty shield (DX-A to DX-AB-1, R. 163-173) the shields made at Boys Technical High School of Milwaukee (DX-C to DX-C-3, R. 175-179) and the shield of Kelleher patent 1,633,412 (PX-4C and PX-6, R. 129, 276) did not satisfactorily supply this long felt want and need and show prior efforts and failures of others in the art to solve the problems encountered in providing a satisfactory grinder shield (F. 8, R. 215). These facts, which are not refuted by any evidence submitted by the defendant, constitute the basis for the court's findings and are supported by respondents disinterested witnesses Doyle, safety inspector for the Industrial Commission of Wisconsin (R. 13); Rasmussen, instructor in the machine shop of Boys Technical High School of Milwaukee (R. 105); defendant's own witnesses Bernitt and Mickelson (DX-N, R. 191-192) and McNulty (R. 98); and from trade publications of general circulation (PX-5, PX-9B); as well as witnesses in the employ of plaintiff. The record clearly establishes a want or need unsupplied for

over one hundred and fifty years and as hereinbefore pointed out, remarkable commercial success by a small company founded by the inventor in open competition with the largest of the national chain distributing organizations such as Sears Roebuck, Western Auto Supply and many others with sales made at about twice the price of the competitive machines and about 25% of the sales made for use on machines for which the patented safety shields were not adapted, requiring special adaptations by such purchases. Surely this record warrants the lower courts in their application of the various criteria repeatedly and still recognized by this Honorable Court as evidence of invention, as shown by the decision of this court in *Goodyear Tire & Rubber Co., Inc., et al.* v. *Ray-O-Vac Co.*, 321 U. S. 275 and *Paramount* v. *Tri-Ergon*, 294 U. S. 464.

As a matter of fact, a want of half a century was deemed sufficient in applying the foregoing criteria in the Ray-O-Vac Case, in which Mr. Justice Roberts, speaking for the court in holding the patent in suit valid and infringed, said, page 279:

> "Viewed after the event, the means Anthony adopted seem simple, and such as should have been obvious to those who worked in the field, but this is not enough to negative invention. During a period of half a century, in which the use of flashlight batteries increased enormously, and the manufacturers of flashlight cells were conscious of the defects in them, no one devised a method of curing such defects. Once the method was discovered it commended itself to the public as evidenced by marked commercial success. These factors were entitled to weight in determining whether the improvement amounted to invention, and should in a close case, tip the scales in favor of patentability."

This reasoning has been consistently followed by this Honorable Court as shown by the decision in *Paramount Corp* v. *Tri-Ergon Corp.*, 294 U. S. 464, wherein Mr. Justice Stone, later Chief Justice, said, page 474:

"• • • Evidence of great utility of a method or device, it is true, may in some circumstances be accepted as evidence of invention. Where the method or device satisfies an old and recognized want, invention is to be inferred, rather than the exercise of mechanical skill. For mere skill of the art would normally have been called into action by the generally known want. See Loom Co. v. Higgins, 105 U. S. 580, 591; Krementz v. Cottle Co., 148 U. S. 556, 560; Hobbs v. Beach, 180 U. S. 383, 392; Carnegie Steel Co. v. Cambria Iron Co., 185 U. S. 403, 429, 430; Expanded Metal Co. v. Bradford, 214 U. S. 366, 381."

While in the latter case the proofs were found not to have established the necessary old and recognized want, here where the evidence shows a need for one hundred fifty years; that the patented structure has solved the grinder shield problems (R. 15, 30-33, 37, 39, 40, 42-44, 47, 64, 71, 106-109, and DX-N, R. 191-193); that the Surty Manufacturing Company manufacturers of defendant's alleged prior art shields acknowledged the advance made by the patented structure by copying the twin light shield and then taking a license under the patent in suit (R. 24, 25); substantial sales were made in spite of higher prices, established chain store competition, the initial reluctance of salesmen and dealers and bad market conditions in the absence of advertising (R. 31, 32, 37, DX-8, R. 143); a spontaneous demand resulting in sales amounting to 25% of plaintiff's production of shields developed for use on other grinders for which they were not designed (R. 32); an even more striking history supporting the presence of invention than existed in the Ray-O-Vac case, is shown. It, accordingly, is respectfully submitted that the authorities relied upon by petitioner to support its petition for certiorari are not in point here, and that certiorari should not be granted.

Respectfully submitted,

William A. Strauch,
Counsel for Respondent.

J. Matthews Neale,
Strauch & Hoffman,
Of Counsel.